UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/192,583	11/17/1998	TETSURO MOTOYAMA	5244-0084-2X	9978

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EXAMINER
HO, CHUONG T

ART UNIT	PAPER NUMBER
2664	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 October 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-53</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-53</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

1.   The amendment filed 10/05/04 have been entered and made of record.

1.   Applicant's arguments filed 10/05/04 have been fully considered but they are not

persuasive.

In the page 16, lines 8-11, claims 18, 40, the Applicant alleged "the Office Action does

not specifically indicate whether the '694 patent discloses the device driver recited in

Claims 18 and 40. Moreover, Applicants respectfully submit that the "694 patent fails to

discloses a device driver, and thus cannot disclose processing information by a device

driver within the computer, as recited in Claims 18 and 40."

The Applicant's argument is not persuasive.

See col. 1, lines 11-15, U.S.Patent No. 6,219,694 B1 discloses the device driver recited

in Claims 18 and 40. Moreover, U. S. Patent No. 6,219,694 disclose processing

information by a device driver within the computer, as recited in Claims 18 and 40 (see

col. 1, lines 11-15, the system and method of the present invention provide an **event-**

driven redirection computer program ("redirector program") operating **at** the host

system, which, upon sensing a particular user-defined event has occurred, redirects

user-selected data items from the host system to the user's mobile data communication

device (Business office device including CPU); Clearly, U.S.Patent No. 6,219,694 B1

discloses the device driver recited in Claims 18 and 40.

1.   Claims 1-53 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-3, 8, 12, 23, 24, 25, 31, 34, 45, 46, 50, 51   are rejected under 35

U.S.C. 102(e) as being anticipated by Lazaridis et al. (U.S.Patent No. 6,219,694 B1).

In the claims 1, 23, Lazaridis et al. discloses determining a system for pushing

information from a host system (a computer) to a mobile data communication device (a

business device) upon sensing a triggering event is discloses (see abstract). A

redirector program operating at the host system (a computer) enables a user to

continuously redirect certain user's mobile data communication device upon detecting

the one or more user-defined triggering events has occurred (see abstract); A list of

message characteristics that determine whether a message is to be redirected. If

activated, the preferred list mode causes the redirector program 12 to operate like a

filter, only redirecting certain user data items based on whether the data item was sent

from a sender on the preferred list or has certain message characteristics that if present

will trigger or suppress redirection of the message (see col. 8, lines 9-11); comprising:

Receiving an electronic mail message by a computer; determining whether the received

message includes instructions (the word "instruction" is the characteristic of the e-mail)

for operation a device associated with the computer by detecting a characteristic of the

message, the device being a business office device including a processing (see

abstract, col. 8, lines 9-11);

Transmitting a communication from the computer (user's desktop system 10) to the

device (a mobile data communication device) if the determining step determines that the

received message includes instructions for the device (see abstract, determining a

system for pushing information from a host system (a computer) to a mobile data

communication device (a business device) upon sensing a triggering event is

discloses); (see astract, A redirector program operating at the host system (a

computer) enables a user to continuously redirect certain user's mobile data

communication device upon detecting the one or more user-defined triggering events

has occurred); (see col. 8, lines 9-11, a list of message characteristics that determine

whether the data item was sent from a sender on the preferred list or has certain

message characteristic that if present will trigger or suppress redirection of the

message);

operating the processor of the device (a mobile data communication device) in

response to the communication (see col. 8, lines 32-55, once the message (A or B) is

received by the mobile device 24), the outer envelop B is removed and the original

message A is placed in the secondary memory store within the mobile device 24. By

repacking and removing the outer envelop in this manner, the present invention causes

the mobile computer 24 to appear to be the same physical location as the host system

10, thus creating a transparent system).

3.   In the claims 2, 24, 34, Lazaridis et al. discloses determining whether the

message which includes instruction (the word "instruction" is the characteristic of the e-

mail) for operating the device or whether the message which has been received has a user of the computer as an end recipient (see abstract, col. 8, lines 9-11).

4.   In the claims 3, 25, Lazaridis discloses displaying, after the receiving step, a message to the user indicating the electronic mail message contains information to be forward to the device, wherein the determining step comprises: determining by a user reading the message which has been received includes instruction (the word "instruction" is the characteristic of the e-mail) is for operating the device (see abstract, col. 8, lines 9-11).

5.   In the claim 8, Lazaridis discloses receiving an Internet electronic mail message (see abstract, col. 8, lines 9-11).

6.   In the claim 12, Lazaridis discloses determining whether the message includes instructions (the word "instruction" is the characteristic of the email) for operating the device automatically by detecting a characteristic of the email (see abstract, col. 8, lines 9-11).

7.   In the claim 45, Lazaridis discloses receiving data from the device, in response to the step of operating the processor; creating an electronic mail message by the computer including the data which has been received; and transmitting over the Internet the electronic mail message generated by the computer (see abstract, col. 8, lines 9-11).

8.   In the claims 46, 31, 50, 51, Lazaridis discloses executing, by a device driver of the computer, commands for at least one of controlling and monitoring the device (see col. 1, lines 11-15, the system and method of the present invention provide an **event-**

driven redirection computer program ("redirector program") operating **at** the host

system, which, upon sensing a particular user-defined event has occurred, redirects

user-selected data items from the host system to the user's mobile data communication

device (Business office device including CPU).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9.   Claim 4 , 9, 10, 13-15, 26, 27, 48, 32, 35-37, 52   are rejected under 35 U.S.C.

103(a) as being unpatentable over Lazaridis et al. (U.S.Patent No. 6,219,694 B1) in

view of Kuwabara (U.S.Patent No. 6,065,136).

In the claims 4, 48, 26, 32, Lazaridis et al. discloses the limitations of claim 3 above.\

However, Lazaridis et al. Is silent to disclosing executing a command which the step of

transmitting to be performed.

Kuwabara, see figure 1, discloses receiving an electronic mail message by a computer

(the provider 5); determining whether the received email includes instruction (addressee

mail code column ML1 that it has bee addressed to the maker's provider (a business

office device)) for operating a device (the maker's provider 8) associated with computer

(the provider 5), the device (the maker's provider 8) being a business office device

including a processor; comprising:

Executing a command which causes the step of transmitting to be performed (see col.

5, lines 32-35, when this electronic mail from User A is received, the provider 5 (the

computer) **identifies** from **its addressee mail code column ML1** (execute program

code) that it has been addressed to the maker's provider 8 (the business office devices)

and serves to transmit it **to** the address provider 8 (the business office devices) through

a telephone line T4 considered to be the optimum route).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the system of Lazaridis with the teaching of Kuwabara to provide

executing program codes in order to causes to transmit a communication from the

computer (associated with business office device) to the device. Therefore, the

combined system would have been enable the combined system to carry out diagnosis

of troubles.

10.   In the claims 9, 27, Lazaridis discloses the step of executing a command

comprises transmitting information to a device driver executing within the the computer;

and the step of transmitting is performed using the device driver (see col. 1, lines 13-

16).

11.   In the claim 10, Lazaridis discloses receiving, by the device, the communication

transmitted from the computer; and transmitting parameters from the device to the

computer, in response to the communication which has been received by the device

(see col. 6, lines 42-45).

12.   In the claims 13, 35, 36, 37, 52, Kuwabara discloses determining that the

message includes instructions for operating the device automatically by detecting a

code within the message (see col. 5, lines 32-35, when this electronic mail from User A

is received, the provider 5 (the computer) **identifies** from **its addressee mail code**

column ML1 (execute program code) that it has been addressed to the maker's

provider 8 (the business office devices) and serves to transmit it **to** the address provider

8 (the business office devices) through a telephone line T4 considered to be the

optimum route).

13.   In the claim 14, Kuwabara discloses determining that the message includes

instructions for operating the device automatically by detecting a code within the

message (see col. 5, lines 32-35, when this electronic mail from User A is received, the

provider 5 (the computer) **identifies** from **its addressee mail code column ML1**

(execute program code) that it has been addressed to the maker's provider 8 (the

business office devices) and serves to transmit it **to** the address provider 8 (the

business office devices) through a telephone line T4 considered to be the optimum

route).

14.   In the claim 15, Kuwabara discloses determining that the message includes

instructions for operating the device automatically by detecting a code within the

message (see col. 5, lines 32-35, when this electronic mail from User A is received, the

provider 5 (the computer) **identifies** from **its addressee mail code column ML1**

(execute program code) that it has been addressed to the maker's provider 8 (the

business office devices) and serves to transmit it **to** the address provider 8 (the

business office devices) through a telephone line T4 considered to be the optimum

route).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15.   Claims 5, 6, 7, 11, 16, 17, 27, 28, 29, 30, 47, 33, 38, 39 are rejected under 35

U.S.C. 103(a) as being unpatentable over the combined system (Lazaridis – Kuwabara)

in view of Zerber (U.S.Patent No. 5,951,636).

In the claims 5, 6, 7, 27, 33, the combined system (Lazaridis – Kuwabara) discloses the

limitations of claim 1 above.

However, the combined system (Lazaridis – Kuwabara) is silent to disclosing the

executing program code of a file which is attached to the message by a manual action

by the user.

Zerber discloses executing program code of a file which is attached to the message by

a manual action by the user (see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the combined system (Lazaridis – Kuwabara) with the teaching of

Zerber to execute program code of a file which is attached to the message by a manual

action in order to limit to only those messages the user want to download.

16.   In the claims 6, 29, Zerber et al. discloses executing the program code of the file

by pointing, using a pointing device and graphical user interface, to an object

representing the file (see abstract).

17.   In the claims 7, 28, Zerber et al. discloses executing the code by pressing a

button while pointing the object representing the file (see abstract).

18.   In the claim 11, Zerber et al. discloses performing a mechanical action by the

device, in response to the communication which has been received by the device (see

abstract).

19.   In the claims 16, 17, 30, 38, 39, Zerber et al. discloses the determining step is

performed in response to a receipt of an incoming electronic mail message (see col. 2,

lines 30-65).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20.   Claims 18-22, 40-44 are rejected under 35 U.S.C. 102(e) as being anticipated

by Lazaridis et al. (U.S.Patent No. 6,219,694 B1).

In the claims 18, 40, See figure 1, Lazaridis et al. discloses transmitting information from

a device (a mobile data communication device) to a computer (a host system)

associated with the device (a mobile data communication device), the device (mobile

data communication device) being a business office device including a processor (see

figure 1, see abstract, col. 8, lines 9-11);

processing the information by a device driver within the computer (see col. 1, lines 11-

15, the system and method of the present invention provide an **event-driven** redirection

computer program ("redirector program") operating **at** the host system, which, upon

sensing a particular user-defined event has occurred, redirects user-selected data items

from the host system to the user's mobile data communication device (Business office

device including CPU);

transmitting, by the computer (a host system), an electronic message corresponding to

the information (see col. 8, lines 9-11).

21.   In the claims 19, 41, Lazaridis et al. discloses transmitting the information from

the device deriver to a messaging application programming interface (MAPI) of the

computer; and processing the information by the MAPI, wherein the step of transmitting

the electronic mail message comprises transmitting the electronic mail message

corresponding to the information which has been processed by the MAPI (see col. 7,

lines 31-45).

22.   In the claims 20, 42, Lazaridis et al. discloses the computer is a message

transfer agent, the step of transmitting information from the device transmits the

information from the device directly to the computer which is the message transfer

agent, and the step of transmitting the electronic mail message transmits the electronic

mail message using a TCP connection from the computer which is a message transfer

agent (see col. 8, lines 32-35).

In the claims 21, 43, Lazaridis et al. discloses creating a file corresponding to the

information; and writing the file to a mail spool directory of the computer; and wherein

the step of transmitting the electronic mail message comprising transmitting the

electronic mail message corresponding to the information using the file stored in the

mail spool directory (see col. 7, lines 35-37).

In the claims 22, 44, Lazaridis et al. discloses creating and writing comprising creating a

plurality of files and writing the plurality of files in the mail spool directory; and

transmitting the electronic mail message using each of the plurality of files stored in the

mail spool directory (see col. 7, lines 31-40).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

23.   Claims 47, 49, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Lazaridis et al. (U.S.Patent No. 6,219,694) in view of of Miyachi (U.S.Patent No.

6,108,492).

In the claims 47, 49, 53, Lazaridis discloses the limitations of claim 1 above.

However, Lazaridis et al. is silent to disclosing the business office device at least one of generates an image on a recording medium and scans an image on a recording medium.

Miyachi discloses wherein the business office device at least one of generates an image on a recording medium and scans an image on a recording medium (see col. 2, lines 27-35).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Lazaridis with the teaching of Miyachi to provide the business office device at least one of generates an image on a recording medium and scans an image on a recording medium in order to carry out remote diagnose of troubles in business communication devices.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
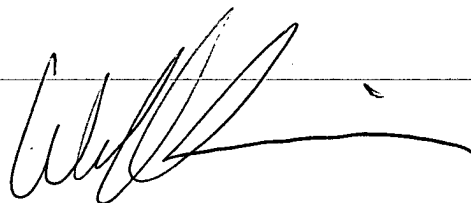
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuong ho whose telephone number is (571)272-3133. The examiner can normally be reached on Monday-Friday from 8:00AM-4:00PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/21/04